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02 APR 2007

In re Application of
Morton et al.
Application No.: 10/554,656
PCT No.: PCT/GB04/01729
Int. Filing Date: 23 April 2004
Priority Date: 25 April 2003
Attorney Docket No.: CXR101.ORD
For: Control Means For Heat Load
In X-Ray Scanning Apparatus

DECISION

This is in response to applicants' response to the decision under 37 CFR 1.497(d), filed on 28 March 2007.

DISCUSSION

In response to the correspondence filed on 17 October 2006 (and the declaration of inventorship filed on 25 October 2005), a decision was mailed on 29 January 2007, stating in part that

Inspection of the declaration of inventorship filed on 25 October 2005 reveals that it nominates the same inventive entity as appears on the published international application. However, Russell David Luggar has not executed the declaration, and the section listing data pertaining to him appears to have been altered by being crossed out. The declaration is defective both because Mr. Luggar's signature is missing and because of said un-initialed alteration. The correspondence filed on 17 October 2006 states in part that

Applicant requests that the inventorship be amended to reflect the true and correct inventorship of the present application. In the original filing, Mr. Russell David Luggar was recognized as an inventor. Mr. Luggar is not an inventor of the claims as currently pending. Applicant therefore requests that Mr. Luggar's name be removed as an inventor. Consequently, an oath or declaration from Mr. Luggar is not required.

In view of this statement, which indicates that the reason for the absence of Mr. Luggar's signature is that he is allegedly not a proper inventor (as opposed to being unavailable per 37 CFR 1.42, 1.43 or 1.47), counsel's attention is drawn to 37 CFR 1.497(d), under which the instant correspondence is being treated. A declaration filed under 37 CFR 1.497 (d) must be by the actual inventor or inventors as required under 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47. The declaration must be accompanied by (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part, (2) the processing fee set forth in 37 CFR 1.17; and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee (See 37 CFR 3.73(b)). See Section 201.03 of the Manual of Patent Examining Procedure (M.P.E.P.).

Regarding requirement (1), applicants have not provided an appropriate statement by Russell David Luggar. Accordingly, requirement (1) has not been satisfied.

Regarding requirement (2), the required processing fee has not been paid.

Regarding requirement (3), inspection of the published international application suggests that CRX Limited may enjoy an assignment interest in the instant application, but no written consent of the assignee has been provided.

In response, counsel now states that

A review of the inventorship records, however, revealed that Mr. Luggar is, in fact, an inventor and, therefore, should (and did) execute a compliant oath and declaration. In that light, Applicant is submitting Mr. Luggar's signature on a compliant oath and declaration. The executed oath and declaration accompanies this submission. Applicant therefore withdraws its request to modify the inventorship of the present application.

Review of the declaration document filed on 28 March 2007 reveals that it nominates inventors Morton and Luggar, but that it does not nominate the other joint inventor (Paul De Antonis) who was named in the published international application. Meanwhile, review of the declaration document signed by Messrs. Morton and De Antonis, which was filed on 25 October 2005, reveals that it is defective in that it includes an un-initialed alteration (specifically, the section referring to Mr. Luggar has been crossed out). Therefore, it is not clear what inventive entity was being nominated when Messrs. Morton and De Antonis executed the declaration. Therefore, a new oath or declaration nominating and executed by the entire inventive entity is required.

CONCLUSION

The request under 37 CFR 1.497(d) is **DISMISSED AS MOOT**, without prejudice.

Applicants have the longer of (a) **TWO (2) MONTHS** from the date of the decision mailed on 29 January 2007 (as extended pursuant to 37 CFR 1.136(a)) or (b) **ONE (1) MONTH** from the mail date of this decision (**NOT** extendable under 37 CFR 1.136(a)) in which to file the response described above - that is, an oath or declaration compliant with 37 CFR 1.497(a) and (b). Failure to timely reply will result in **ABANDONMENT** of this application.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the Office of PCT Legal Administration.



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